

REMARKS

Reconsideration of the application is respectfully requested.

I. Status of the Claims

Claims 1 – 18 are pending, with claims 14 – 18 having previously been withdrawn due to restriction. Applicants amend claims 1, 3 and 12, and add new claims 19 and 20. No new matter is introduced. Support for the amendments may be found, for example, with reference to Applicants' specification at page 22, line 3 through page 24; line 15, page 55, line 15 through page 56, line 6; page 60, lines 2 – 23; and page 61, lines 1 - 26.

II. Amendments to the Specification

Applicants amend the specification to correct a typographical error. Specifically, Applicants amend the paragraphs beginning at page 21, line 26 to provide that FIGs. 13 and 14 respectively provide cross-sectional views taken along lines I-I' and II-II' of FIG. 12. Applicants respectfully request that the amendments to the specification be accepted and entered.

II. Rejections under 35 U.S.C. § 102

Claims 1, 2, 7, 8 and 13 are rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent Application No. JP 2002-324585 to Japan Storage Battery Co. Ltd. ("Murai"). Applicants amend claim 1 to further clarify the nature of their invention, and respectfully traverse the rejections of claims 1, 2, 7, 8 and 13 under 35 U.S.C. § 102(b).

In amended independent claim 1, Applicants claim:

1. An electrical storage device with an outer container comprising:

a positive electrode, a negative electrode, a lithium electrode and an electrolyte capable of transferring lithium ions, provided inside the container of the electrical storage device, wherein:

the positive electrode, the negative electrode and the lithium electrode are each respectively formed on a positive electrode collector, a negative electrode collector and a lithium electrode collector,

the lithium electrode is arranged to be out of direct contact with the negative electrode and/or the positive electrode,

a positive electrode terminal is welded to a protrusion of the positive electrode collector, a negative electrode terminal is welded to a protrusion of the negative electrode collector, and a lithium electrode terminal is welded to a protrusion of the lithium electrode collector,

the positive electrode terminal, the negative electrode terminal and the lithium electrode terminal include portions located outside the container of the electrical storage device, and

wherein lithium ions can be supplied to the negative electrode and/or the positive electrode by flowing current between the lithium electrode and the negative electrode and/or the positive electrode through an external circuit which connects the lithium electrode terminal with the negative electrode terminal and/or the positive electrode terminal outside the container.

(Emphasis added).

Murai discloses a nonaqueous electrolyte secondary battery comprising an outer container including a positive electrode having a terminal 4, a negative electrode having a terminal 5, a lithium terminal having an electrode 7. As depicted in FIG. 3 of Murai, each of the terminals 4, 5 and 7 extends outside of the container 2, and a circuit 14 couples electrodes 5 and 7.

Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See, e.g., *In re Spada*, 911 F.2d 705, 707, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). In sharp contrast to Applicants' amended independent claim 1, Murai does not disclose Applicants' claimed electrode arrangement in which the positive electrode, the negative electrode and the lithium electrode are each respectively formed on a positive electrode collector, a negative electrode collector and a lithium electrode collector.

Applicants submit therefore that amended independent claim 1 is not anticipated by Murai and stands in condition for allowance. As claims 2, 7, 8 and 13 depend from allowable independent claim 1, Applicants further submit that dependent claims 2, 7, 8 and 13 are also not anticipated by Murai and allowable for this reason.

Accordingly, Applicants respectfully request that the rejections of claims 1, 2, 7, 8 and 13 under 35 U.S.C. § 102(b) be withdrawn.

III. Rejections under 35 U.S.C. § 103

Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Murai in view of U.S. Patent No. 6,461,769 to Ando et al. ("Ando '769"). Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Murai in view of U.S. Patent No. 6,653,018 to Takahashi et al. ("Takahashi") or U.S. Patent No. 6,576,365 to Meitav et al. ("Meitav"). Claims 1, 2, 4, 6 – 10, 12 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,862,168 to Ando et al. ("Ando '168") in view of Murai. Claims 3 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ando '168 in view of Murai and Ando '769. Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ando '168 in view of Murai and Takahashi or Meitav. Claims 1 – 4 and 6 – 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ando '769 in view of Japanese Patent Application No. JP 08-190934 to Hitachi Ltd. ("Muranaka") or Murai. As noted above, Applicants amend independent claim 1 to further clarify the nature of their invention, and respectfully traverse the rejections of claims 1 – 13 under 35 U.S.C. § 103(a).

As noted above with reference to the rejection of amended independent claim 1, Applicants submit that Murai fails to disclose Applicants' claimed electrode arrangement in which the positive electrode, the negative electrode and the lithium electrode are each respectively formed on a positive electrode collector, a negative electrode collector and a lithium electrode collector. With reference to former claim 3, which claimed that the positive electrode and the negative

electrode were respectively formed on a positive electrode collector and a negative electrode collector, the Examiner suggests that each of Ando '168 and Ando '769 disclose this feature.

Amended independent claim 1 in addition claims a positive electrode terminal that is welded to a protrusion of the positive electrode collector, a negative electrode terminal that is welded to a protrusion of the negative electrode collector provided on the negative electrode, and a lithium electrode terminal is that is welded to a protrusion of the lithium electrode collector. Applicants respectfully submit that this claimed feature is neither disclosed or suggested by Ando '168 or Ando '769, or by any of the other cited references, and that the *Graham* requirements for finding amended independent claim 1 to be obvious are not met. See, e.g., MPEP § 2143(A).

For at least this reason, Applicants submit that amended independent claim 1 is not made obvious by any of the cited references, and stands in condition for allowance. As claims 2 – 13 each depend either directly or indirectly from allowable independent claim 1, Applicants further submit that dependent claims 2 – 13 are also allowable for at least this reason.

Therefore, Applicants respectfully request that the rejections of claims 1 – 13 under 35 U.S.C. § 103(a) be withdrawn.

IV. New Claims

Applicants add new claims 19 and 20. As each of new claims 19 and 20 depends indirectly from allowable independent claim 1 via allowable dependent claim 8, Applicants submit that new claims 19 and 20 are also allowable for at least this reason.

CONCLUSION

In view of the above amendments and remarks, Applicants believe the pending application is in condition for allowance. If there are any remaining issues which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment,

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the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below

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Respectfully submitted,

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